IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Earney E. Stoutenburg

Serial No.: 09/965,083

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For: ELECTRONIC ACKNOWLEDGMENT OF RECEIPT OF INVENTORY

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Examiner: McClellan, James S.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Sir:

This is an Appeal Brief for the appeal of the final rejection of claims 15-26 in the Final Office Action dated November 3, 2004. This application was filed on September 26, 2001.

I. REAL PARTY IN INTEREST

The real party in interest is First Data Corporation, a corporation organized and existing under the laws of the state of Delaware, and having a place of business at 401 Hackensack, Hackensack, New Jersey, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on September 26, 2001, Reel 012215/Frame 0284.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to the Appellants, the Appellants' legal representative, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 15-26 stand finally rejected and are the subject of this appeal. These claims are reproduced in Appendix A. Of the pending claims, claims 15, 24 and 26 are the only independent claims.

IV. STATUS OF AMENDMENTS

No amendment after final rejection was filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

1. Independent Claim 15

Independent claim 15 recites a system for tracking status of an inventory shipment sent to a recipient. (Specification, p. 3, ll. 13-14, and p. 6, ll. 6-8.) The system includes a host computer for receiving an electronic acknowledgment of receipt of inventory from the recipient. (See specification, p. 4, l. 18, through p. 6, l. 4; and Fig. 1, ref. no. 20.) The host computer is operable to automatically transmit a message to the recipient requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first predetermined amount of time. (Specification, p. 7, ll. 12-16.)

2.   **Independent Claim 24**

Independent claim 24 also recites a system for tracking status of an inventory shipment sent to a recipient. (Specification, p. 3, ll. 13-14, and p. 6, ll. 6-8.) The system includes a terminal for transmitting an electronic acknowledgment of receipt of inventory, and a host computer in communication with the terminal for receiving the electronic acknowledgment. (See specification, p. 4, l. 18, through p. 6, l. 4; and Fig. 1, ref. nos. 22 and 20.) The host computer is operable to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time. (Specification, p. 7, ll. 12-16.) The host computer is further operable to inhibit operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time. (Specification, p. 8, ll. 13-16.)

3.   **Independent Claim 26**

Independent claim 26 also recites a system for tracking status of an inventory shipment sent to a recipient. (Specification, p. 3, ll. 13-14, and p. 6, ll. 6-8.) The system includes a terminal (e.g., ref. no. 22 in Fig. 1) disposable at a first location (e.g., ref. no. 16 in Fig. 1) and being configured to transmit an electronic acknowledgment of receipt of inventory. (Specification, p. 5, l. 7, through p. 7, l. 4.) The system further includes a host computer (e.g., ref. no. 20 in Fig. 1) disposable at a second location (e.g., ref. no. 12 in Fig. 1) different than the first location, wherein the host computer is operable to transmit a message to the terminal indicating that the inventory shipment has been sent. (Specification, p. 4, ll. 18-26; and p. 6, ll. 23-24.) The host computer is further configured to receive the electronic acknowledgment from the terminal, and to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time. (Specification, p. 6, l. 26, through p. 7, l. 16.) The host computer is also operable to send a command to the terminal to inhibit

operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time. (Specification, p. 8, ll. 13-16.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 15, 16, 23 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. US 2003/0195811 A1 in the name of Hayes, Jr. et al. (hereinafter "Hayes").

Claims 16-22, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayes in view of U.S. Patent No. 5,638,283 to Herbert (hereinafter "Herbert").

VII. ARGUMENT

1. Claims 15, 16, 23 and 25 are Patentable Under 35 U.S.C. § 102(e) over Hayes

Claim 15 recites that the host computer is "operable to automatically transmit a message to the recipient requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first predetermined amount of time." Contrary to the Examiner's assertion, this feature is not disclosed in Hayes. Instead, Hayes discloses that a customer may use a customer messaging and alerting service (CMAS) to request shipment status. (See paragraph 0040 of Hayes.) Furthermore, it is respectfully believed that paragraph 0049 and Figure 5d of Hayes, to which the Examiner referred in the Office Action, disclose delivery confirmation or guaranteed delivery of a message, rather than an inventory shipment. Thus, the § 102(e) rejection of claim 15 and dependent claims 16, 23 and 25 is believed to be improper and should be reversed.

**2.   Claims 16-22, 24 and 26 are Patentable Under
        35 U.S.C. § 103(a) over Hayes in view of Herbert**

A. The Combination of Hayes and Herbert is Improper

Applicants respectfully believe that the Examiner has failed to establish proper motivation for combining Herbert with Hayes. In that regard, as noted by the United States Court of Appeals for the Federal Circuit, there are three possible sources for a motivation to combine references: "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In Re Rouffet*, 149 F.3d 1350, 47 UPQ2d 1453 (Fed. Cir. 1998).

In this case, the cited references are in different fields of endeavor and are directed to different problems. More specifically, Herbert is directed to a franking machine for printing franking impressions on mail items, while Hayes is directed to a customer messaging service that provides a means for businesses to create alerts for target customers that are routed via each customer's specified alert hierarchy.

Regarding the teachings of the prior art, the Examiner failed to identify any specific teaching of either reference that would motivate one with no knowledge of the present invention to make the combination. Moreover, the Examiner failed to identify or explain any specific understanding or principle within the knowledge of one of ordinary skill in the art that would motivate one with no knowledge of the present invention to make the combination.

For these reasons, Appellants respectfully believe that the Examiner has failed to establish proper motivation for combining Herbert and Hayes, which are believed to be from non-analogous arts. In that regard, it is noted that "[t]he combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness." *In re Oetiker*, 24

USPQ2d 1443, 1446 (Fed. Cir. 1992). As a result, Appellants respectfully believe that the Examiner has failed to make a *prima facie* case that claims 16-22, 24 and 26 are unpatentable under § 103(a) over Hayes in view of Herbert, and that the rejection should therefore be reversed.

B. The Combination Still Falls Short of the Claimed Subject Matter

Even if the references were properly combinable, however, it is respectfully believed that the combination still falls short of the subject matter claimed in any of claims 16-22, 24 and 26.

1). Claims 16-22

Regarding dependent claims 16-22, because Herbert fails to cure the above noted deficiencies of Hayes with respect to independent claim 15, the § 103(a) rejection of dependent claims 16-22, which claims each include the features of claim 15, is believed to be improper.

It should also be noted that many of the above dependent claims recite additional features that are not disclosed in any of the cited references, either alone or in combination.

a). Claim 17

For example, claim 17 recites that "the terminal is further operative to automatically inhibit operation of the terminal if the terminal is not instructed to print the message within a second, predetermined amount of time." As acknowledged by the Examiner, Hayes "fails to disclose inhibiting operation of a terminal ..." (Office Action, p. 3.) Nor does Herbert disclose a terminal that inhibits operation of itself if the terminal is not used to print a message requesting acknowledgment of receipt of inventory, as claimed in claim 17. By

contrast, Herbert discloses a franking machine having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver 18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 17.

b). Claim 18

Claim 18, which depends from claim 17, recites that "the terminal is further operative to automatically restore operation of the terminal after the terminal is instructed to print the message." As acknowledged by the Examiner, Hayes "fails to disclose ... enabling operation of a terminal." (Office Action, p. 3.) Nor does Herbert disclose a terminal that is operative to restore operation of itself after the terminal is instructed to print a message requesting acknowledgment of receipt of inventory, as claimed in claim 18. Instead, as noted above, Herbert discloses a franking machine having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver 18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 18.

c). Claim 19

Claim 19 recites that "the host computer is further operable to inhibit operation of the terminal if the recipient does not print the message within a second, predetermined amount of time." As noted above, the Examiner acknowledged that Hayes "fails to disclose inhibiting operation of a terminal ..." (Office Action, p. 3.) Nor does Herbert disclose the above feature of claim 19. Instead, as noted above, Herbert discloses a franking machine

having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver 18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 19.

d). Claim 20

Claim 20, which depends from claim 19, recites that "the host computer is further operable to restore operation of the terminal after the terminal prints the message." As noted above, the Examiner acknowledged that Hayes "fails to disclose ... enabling operation of a terminal." (Office Action, p. 3.) Nor does Herbert disclose the above feature of claim 20. Instead, as noted above, Herbert discloses a franking machine having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver 18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 20.

e). Claim 21

Claim 21 recites that "the host computer is further operable to inhibit operation of the terminal if the recipient does not respond to the message within a second, predetermined amount of time." As noted above, the Examiner acknowledged that Hayes "fails to disclose inhibiting operation of a terminal ..." (Office Action, p. 3.) Nor does Herbert disclose the above feature of claim 21. Instead, as noted above, Herbert discloses a franking machine having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver

18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 21.

f). <u>Claim 22</u>

Claim 22, which depends from claim 21, recites that "the host computer is further operable to restore operation of the terminal after the recipient responds to the message." As noted above, the Examiner acknowledged that Hayes "fails to disclose ... enabling operation of a terminal." (Office Action, p. 3.) Nor does Herbert disclose the above feature of claim 22. Instead, as noted above, Herbert discloses a franking machine having a microprocessor 10 and a global positioning system receiver 18 located in a secure housing 17, and the microprocessor 10 is operable to inhibit operation of the franking machine if there is a mismatch between stored location data and location data output from the receiver 18. (See col. 2, ll. 52-57, col. 4, ll. 38-48, and Fig. 1 of Herbert.) Thus, even if Hayes and Herbert were properly combinable, the combination still falls short of claim 22.

2). <u>Claim 24</u>

Regarding independent claim 24, that claim recites that the host computer is "operable to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time." Moreover, claim 24 also requires that the host computer be "operable to inhibit operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time." Because neither Hayes nor Herbert discloses either of the above features, claim 24 is believed to be patentable even if the combination of those references were proper.

3). <u>Claim 26</u>

Regarding independent claim 26, that claim recites the following:

> a terminal disposable at a first location and being configured to transmit an electronic acknowledgment of receipt of inventory; and
> a host computer disposable at a second location different than the first location, the host computer being operable to transmit a message to the terminal indicating that the inventory shipment has been sent, the host computer further being configured to receive the electronic acknowledgment from the terminal, and to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time, the host computer also being operable to send a command to the terminal to inhibit operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time.

Because none of the cited references, either alone or in combination, discloses the above combination of features, claim 26 is believed to be patentable even if the cited references were properly combinable. More specifically, neither Hayes nor Herbert discloses a host computer that is operable to automatically transmit a message to a terminal requesting acknowledgment of receipt of inventory if an electronic acknowledgment of receipt of inventory is not received from the terminal within a first, predetermined amount of time. Furthermore, neither reference discloses a host computer and terminal that are disposable at different locations, wherein the host computer is operable to send a command to the terminal to inhibit operation of the terminal if the terminal does not transmit an electronic acknowledgment of receipt of inventory to the host computer within a second, predetermined amount of time.

4). <u>Limitations Following "If" Statements are Positively Claimed</u>

It should also be noted that Appellants respectfully disagree with the Examiner's assertion that "[t]he limitations following the 'if' statement are not positively claimed." (Office Action, p. 4.) Each claim that includes an if statement is believed to be definite and requires that the system have a certain configuration and/or be operable to perform a certain function in the event that the condition following the term "if" occurs. Rather than including an alternative expression as asserted by the Examiner, each claim that includes an if statement recites a conditional expression. It is believed to be improper to ignore this language, as the Examiner proposes, by arguing that if the recited condition does not occur, then the entire expression is irrelevant.

CONCLUSION

In view of the foregoing, the Appellants respectfully request that the Board reverse the final rejection of claims 15-26 over the cited prior art.

A check covering the fee of $500.00 as applicable under the provisions of 37 C.F.R. § 41.20(b)(2) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,

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APPENDIX A

15.   A system for tracking status of an inventory shipment sent to a recipient, the system comprising:

a host computer for receiving an electronic acknowledgment of receipt of inventory from the recipient, the host computer being operable to automatically transmit a message to the recipient requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first predetermined amount of time.

16.   The system of claim 15 further comprising a terminal in communication with the host computer, the terminal being operable to transmit the electronic acknowledgment to the host computer and to receive the message from the host computer.

17.   The system of claim 16 wherein the terminal is further operative to automatically inhibit operation of the terminal if the terminal is not instructed to print the message within a second, predetermined amount of time.

18.   The system of claim 17 wherein the terminal is further operative to automatically restore operation of the terminal after the terminal is instructed to print the message.

19.   The system of claim 16 wherein the host computer is further operable to inhibit operation of the terminal if the recipient does not print the message within a second, predetermined amount of time.

20.   The system of claim 19 wherein the host computer is further operable to restore operation of the terminal after the terminal prints the message.

21.   The system of claim 16 wherein the host computer is further operable to inhibit operation of the terminal if the recipient does not respond to the message within a second, predetermined amount of time.

22.   The system of claim 21 wherein the host computer is further operable to restore operation of the terminal after the recipient responds to the message.

23.   The system of claim 16 wherein the host computer is further operable to transmit a notice to the terminal indicating that the shipment has been sent.

24.   A system for tracking status of an inventory shipment sent to a recipient, the system comprising:

a terminal for transmitting an electronic acknowledgment of receipt of inventory; and

a host computer in communication with the terminal for receiving the electronic acknowledgment, the host computer being operable to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time, the host computer further being operable to inhibit operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time.

25. The system of claim 15 further comprising a terminal disposable at a location different than the host computer, the terminal being configured to transmit the electronic acknowledgment to the host computer and to receive the message from the host computer.

26. A system for tracking status of an inventory shipment sent to a recipient, the system comprising:

a terminal disposable at a first location and being configured to transmit an electronic acknowledgment of receipt of inventory; and

a host computer disposable at a second location different than the first location, the host computer being operable to transmit a message to the terminal indicating

that the inventory shipment has been sent, the host computer further being configured to receive the electronic acknowledgment from the terminal, and to automatically transmit a message to the terminal requesting acknowledgment of receipt of inventory if the electronic acknowledgment is not received within a first, predetermined amount of time, the host computer also being operable to send a command to the terminal to inhibit operation of the terminal if the terminal does not transmit the electronic acknowledgment within a second, predetermined amount of time.